

Appl. No. : 09/669,869  
Filed : September 22, 2000

## REMARKS

In response to the Office Action mailed March 4, 2008, Applicants respectfully request the Examiner to reconsider the above-captioned application in view of the following remarks.

### Claims do Not Recapture Surrendered Subject Matter

The Examiner rejected Claims 13 and 16-53 under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the parent application.

### Apparatus Claims – Claims 13, 16-28 and 36-45

In the Office Action the Examiner recognized that the apparatus claims (as listed in the heading) did NOT recapture subject matter of Claim 5. However, the Examiner pointed out that Applicants had focused their analysis on Claim 5 and not Claim 1, and had not specifically addressed two of the limitations added to Claim 1 that were not also added to Claim 5 in the original patent. Accordingly, the Examiner states that these two limitations should be added to the new apparatus claims. Applicants respectfully traverse this rejection, and contend that the subject matter of these two limitations was never surrendered in order to obtain the original patent.

As stated in the MPEP, a reissue application may not recapture subject matter which was surrendered to obtain the original patent. Applicants acknowledge that, during prosecution of the original patent, Applicants added the limitation of one of said upper portions “being substantially coplanar with a respective lower portion” to Claim 1 (and ONLY to Claim 1). Applicants also added to Claim 1 (and ONLY to Claim 1) that the connecting webs were “ integrally attached to said longitudinal members where said upper and lower portions intersect.” However, these limitations were NOT added to Claim 5. Thus, in the patent as issued, Claim 5 was broad enough to cover structural configurations in which none of the upper portions was coplanar with a lower portion. As such, this subject matter plainly is still claimed by Applicants. Similarly, as issued, Claim 5 was broad enough to cover structural configurations in which the web members extended between the longitudinal members at a position other than where the upper and lower portions intersect. As such, this subject matter plainly is still claimed by Applicants.

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Since Applicants (in Claim 5) still claim subject matter that is BROADER than these two limitations of Claim 1, logic requires that Applicants have not “surrendered” this broader subject matter. Notably, Applicants focused their earlier arguments on Claim 5 purely because Claim 5 is broader than Claim 1 in at least these two respects.

Since Applicants never surrendered the subject matter of Claim 1 identified by the Examiner (limitations “D” and “E” – see Office Action, page 5), Applicants contend that a “recapture” rejection is not warranted, and respectfully request that the Examiner withdraw this rejection.

Limitations “Materially Narrow” Reissue Claims

In addition to the discussion above, the apparatus claims do not recapture surrendered subject matter because they include limitations that materially narrow the claims in ways not originally prosecuted. Section 1412.02 (V) of the MPEP states that, even if there appear to be other grounds for a recapture rejection, if reissue claims include a limitation directed to one or more “overlooked aspects” of an invention, such limitation would overcome any recapture rejection. Of course, an “overlooked aspect” is a limitation that had NOT been prosecuted in the original patent application.

Following is an identification of some of the overlooked aspects that were not prosecuted in the original patent application and which materially narrow the reissue claims:

Independent Claim 13: an upper portion in the forefoot section of each support member, having certain features and at least one mount hole, and a separately recited upper portion in the heel section of each support member. These forefoot and heel upper portions are separately recited, and are separate parts. This is in stark structural contrast to original claims 1 and 5, in which there is no such requirement of separate forefoot and heel upper portions.

Dependent Claim 18: nowhere in the original patent was it recited that each mounting flange extends from its respective upper edge in a direction away from the upper portions.

Dependent Claim 19: nowhere in the original patent was it specifically recited that the upper portions in the heel section of the chassis lie in substantially convergent planes.

Independent Claim 22: nowhere in the original patent was it required that there was a planar upper portion in the front region and a planar upper portion in the back region. This is

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structurally narrower than in original Claims 1 and 5, in which there is no such requirement of separate front and back upper portions.

Dependent Claim 23: nowhere in the original patent is it required that the upper portions in the back region line in planes that are inclined relative to their corresponding lower portions.

Dependent Claim 28: nowhere in the original patent was it recited that at least one of the upper portions of each of the chassis member lies in a plane that is inclined between about 60-80 degrees.

Independent Claim 36: nowhere in the original patent was it specifically recited that in the heel section of each support member at least part of each upper portion lies in a plane that is inclined.

Dependent Claim 40: nowhere in the original patent was it recited that at least one of the upper portions is curved.

In addition to the reasons discussed above, since these apparatus claims have limitations that recite “overlooked aspects” that were not prosecuted in the original patent application, Applicants hereby request that the Examiner withdraw the recapture rejection and that these claims be allowed.

#### Method Claims – Claims 29-35 and 46-53

In rejecting the method claims, the Examiner contends that the method claims mimic the apparatus claims. Applicants respectfully contend that the method claims are independently valuable in addition to the apparatus claims. Also, the method claims are materially narrowed, by reciting “overlooked aspects” that were not prosecuted in the original patent application.

For example, Claim 29 recites a substantially planar upper portion in the front region and a substantially planar upper portion in the back region, at least one of the upper portions of each chassis member being angled relative to the respective lower portion. The original patent claims are not so limited to requiring such separate front and back upper portions. Also, the original patent claims do not recite method steps such as the left chassis member, right chassis member and cross member being formed separately (see Claim 30) or the left and right chassis members being welded to the cross member (see Claim 31).

Further method Claim 46 also requires that the left and right chassis members be formed with an upper portion in the front region and a separate upper portion in the back region.

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Further, dependent method Claim 52 requires that at least one of the upper portions is curved. The original patent application did not present such limitations. Instead, these inventive limitations were “overlooked aspects” of the invention.

Overlooked aspects such as those recited in the method claims are not subject to recapture rejections. As such, Applicants respectfully request that the Examiner withdraw the rejection of these claims.

### CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections and objections set forth in the outstanding Office Action are inapplicable to the present claims and specification.

The undersigned has made a good faith effort to respond to all of the rejections in the case. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicants' attorney in order to resolve such issue promptly.

Respectfully submitted,

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Dated: 9/4/08

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